

REMARKS

Reconsideration of the present application is respectfully requested on the basis of the following particulars.

1. New claims

New claims 24-27 are first introduced in the application and recite features of the present invention that are clearly shown and described in the pending application. Claim 24 resembles claim 1 and further recites that the data medium comprises a plurality of depressions located on a side of the data medium opposite the first and second ink areas, and corresponding to the first and second ink areas. Additionally, claims 25-27 depend from claim 24 and recite that the side of the data medium opposite the border line defines a peak, or that the depressions have different depths according to the different ink areas. Support for the subject matter of these new claims is found in FIGS. 2 and 3, and in the specification on page 5, lines 25-32.

Acceptance of the new claims is respectfully requested in the next Office communication from the examiner.

2. Rejection of claims 1, 3, 20 and 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,033,059 (Hutton et al.)

Having carefully reviewed the claims of the present application, the specification, and the drawings of the Hutton et al. disclosure, and the arguments advanced by the examiner in the outstanding Office Action, the applicants respectfully traverse the rejection of claims 1, 3, 20 and 23 on the basis that the Hutton et al. disclosure fails to disclose, either expressly or inherently, each and every limitation of claim 1 of the pending application. Claims 3, 20 and 23 each depend from claim 1 and thus their patentability is based on claim 1 and their individually recited features.

Initially, the applicants assert that the examiner has not properly considered the limitation that the first and second ink areas of claim 1 are “directly adjacent” to each other. In the Action, the examiner indicates that there is a gap between adjacent ink areas 53, 55 in FIG. 15 of the Hutton et al. disclosure. This acknowledgment of a gap between adjacent ink areas in the Hutton et al. disclosure appears at odds with the limitation of claim 1 in that the first and second ink areas are directly adjacent to one another. If indeed there was a gap or clearance between each of the ink areas in the Hutton et al. disclosure, as interpreted by the examiner, such ink areas could not be considered to be “directly adjacent.”

Second, the applicants consider the examiner to have ignored the limitation of a borderline that is both “acute and discrete,” as presently recited in claim 1. The examiner proffers the teachings of FIG. 3 to support his argument that indeed the disclosure of Hutton et al. discloses a borderline of the type recited in claim 1. This analysis is simply wrong by the examiner in that FIG. 3 of Hutton et al. clearly does not show a borderline. At best, Hutton et al. show a clearance spaced between each of the neighboring ink areas 14a, 14 in FIG. 3, but such clearance can hardly be construed as “acute and discrete.”

Third, the applicants do not agree with the examiner that the Hutton et al. disclosure teaches ink areas that have a borderline that is arranged with the aforesaid limitations such that the first and second ink areas do not intermingle with one another, as called for in claim 1. In this regard, the Examiner's determination that the ink areas of Hutton et al. do not intermingle with one another while possessing the aforesaid characteristics appears, at best, speculative. For all the drawings of Hutton et al. show, the neighboring ink areas may just as well intermingle at a shared borderline or by a clearance.

An overall concern of the applicants concerning the rejection of claim 1 is that the examiner has blindly relied on the drawing figures of the Hutton et al. disclosure as evidence that the data medium of claim 1 is taught in the prior art. Of course, the

applicants recognize that drawings in the prior art is available as qualifying teachings of anticipation, however, the applicants maintain that the proffered drawings of Hutton et al. do not sufficiently set forth the recited relationships expressly recited in claim 1. The applicants would like to point out that the ink areas 53, 55 of FIG. 15 of Hutton et al. are inconsistently drawn and the spacing between each of the ink areas is random and largely inaccurate. Thus, these drawings are schematic and can hardly be construed as defining precise relationships of the very type required by claim 1. Moreover, the written specification of Hutton et al. fails to make up for the shortcomings of the drawings, and is thus inadequate in describing or suggesting each and every feature of the ink areas of claim 1.

The Examiner's comments in the Action appear as if the examiner is asserting that FIG. 15 inherently discloses each and every feature of claim 1. As pointed out above, it is the applicants' view that the Examiner's comments are based on sheer speculation, especially since the drawings of Hutton et al. are not drawn to scale and overall, as pointed out above, are largely inaccurate and show inconsistent relationships between neighboring ink areas. It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

It is well understood that absence from a reference of any claimed element negates anticipation, and the applicants submit that the Hutton et al. disclosure fails to teach each of the claimed elements and relationships thereof. As explained, the only evidence provided by the examiner neither reveals that the ink areas of the Hutton et al. disclosure are "directly adjacent" to one another, nor discloses that there exist borderlines that are "acute and discrete" between the directly adjacent ink areas, nor describes that neighboring ink areas do not intermingle with one another.

The amount of evidence provided in support of this rejection is insufficient to sustain a rejection based on anticipation by the prior art.

Thus, when properly interpreted, the disclosure of Hutton et al. appears to require clearances between neighboring ink areas. The Hutton et al. patent does not discuss or show such a ink areas having an acute and discrete borderline wherein the ink areas do not intermingle with one another, but instead describes a general purpose method for using intaglio printing to form transitory images. Although the Hutton et al. patent does describe neighboring ink areas possibly having a clearance therebetween, it does not illustrate each and every feature of the ink areas of claim 1. Thus, even an artisan of ordinary skill must guess about how exactly the teachings of Hutton et al. would substitute for making the data medium of claim 1 and whether the Hutton et al. disclosure would be capable of providing sufficient teachings to make at least some of the features of claim 1.

In fact, the Hutton et al. disclosure makes no explicit suggestion of any kind about its suitability for making the data medium of claim 1. About the most that can be said for the Hutton et al. patent is that it does not explicitly describe anything inconsistent with claim 1. However, this negative pregnant is not enough to show anticipation.

As is well understood, in order to anticipate, a prior art reference must describe the applicants' claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. The applicants respectfully submit that the Hutton et al. disclosure does not sufficiently disclose or suggest the inventive features of claim 1.

In view of the foregoing observations, the applicants courteously request withdrawal of this rejection and allowance of claims 1, 3, 20 and 23.

3. Rejection of claim 2 under 35 U.S.C. § 102(b) as being obvious in view of U.S. 4,033,059 (Hutton et al.)

This rejection is traversed on the basis that claim 2, which depends directly from claim 1, is patentable based on its dependency from claim 1 and its individually recited features. The applicants submit that the Hutton et al. disclosure simply fails to disclose or suggest each and every feature of the data medium of claim 2.

In particular, the applicants submit that the examiner has neglected to provide any specific evidence in the disclosure of Hutton et al. that the minimum in the region of the border line is an ink layer thickness of almost zero. Similar to the defects of the rejection of claim 1, the basis provided by the examiner for this rejections appears as mere conjecture not based on the teachings of the prior art.

As is well understood, there must be a finding as to the specific understanding or principle within the knowledge of the skilled artisan that would have provided the motivation to provide the borderline described in claim 2 in order to qualify as a prior art teaching against the claimed borderline. Although it may be argued that the prior art document of value of Hutton et al. may be capable of being modified to have the borderline recited in claim, there must be some suggestion or motivation in the reference to do so.

The applicants respectfully submit that the Hutton et al. disclosure fails to provide the requisite evidence to justify the proffered rejection of claim 2. In the next communication, the applicants ask for the examiner to provide evidence within the Hutton et al. disclosure itself which would suggest to a skilled artisan the desirability of providing a borderline that results in an ink thickness of almost zero as in claim 2.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-3, 20 and 23-27 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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amendment 230904.wpd

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Justin J. Cassell', with a stylized, flowing script.

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